

## **II. REMARKS**

### **A. Status of the Claims**

Claims 1-19 were pending in the case at the time of the Action. Claims 1 and 16 have been amended in the Amendment set forth herein. Support for the amendments of claims 1 and 16 can be found throughout the specification, such as in the claims as originally filed. No new claims have been added, and no claims have been canceled. Therefore, claims 1-19 are currently under consideration.

### **B. The Rejection Under 35 U.S.C. §102(e) Is Overcome**

Claims 1-11, 13-14, and 16-19 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,384,301 (hereinafter' the "'301 patent"). Applicants respectfully traverse.

It is respectfully submitted that the '301 patent fails to anticipate claims 1-11, 13-14, and 16-19 because it does not expressly or inherently describe each limitation of the claimed invention. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.") Applicants initially note in this regard that independent claims 1 and 16 (and dependent claims 2-11, 13-14, and 17-19) include the element of "obtaining an extract of root tissue from the transformed plant tissue." The '301 patent has not been shown to expressly or inherently disclose such "obtaining an extract of root tissue." The Action cited col. 9, lines 32-43 of '301 as disclosing obtaining a piece of root tissue which tested positive for GUS. However, Applicants note that obtaining an extract of root tissue is not disclosed in this section of the '301 patent, nor is it necessarily required. An analysis for GUS expression does not necessarily require the preparation of an extract of root tissue. Nor has any other disclosure in the '301

patent been shown pertaining to obtaining an extract of root tissue. It is therefore believed that the rejection is moot and removal thereof is thus respectfully requested.

**C. The Claim Rejection Under 35 U.S.C. §103(a) Is Overcome**

Claims 1-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,384,301 (the "'301 patent") as applied to claims 1-11, 13-14, and 16-19 above, in view of U.S. Patent 5,994,624 (the "'624 patent").

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (3) there must be a reasonable expectation of success. *Manual of Patent Examining Procedure* § 2142; see also *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed Cir. 1991) (emphasizing that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not based on applicant's disclosure). It is important to note that all three elements must be shown to establish a *prima facie* case of obviousness. Thus, if one element is missing, a *prima facie* case of obviousness does not exist.

In the instant case, there is no *prima facie* case of obviousness because it has not been shown that the '301 patent and the '624 patent teach or suggest each limitation of the claimed invention. As described above, the '301 patent fails to teach or suggest the limitation of "obtaining an extract of tissue from the transformed plant tissue." As explained, col. 9, lines 32-43 of the '301 patent was cited as disclosing obtaining a piece of root tissue which tested positive for GUS, but no section of the '301 patent was cited as teaching or suggesting obtaining an

extract of plant tissue, nor do Applicants identify any such disclosure in the '301 patent. Furthermore, the '624 patent fails to teach or suggest the missing limitation. This reference is cited as disclosing the use of cotton in the germline transformation process, and not obtaining an extract of root tissue from a transformed plant. Additionally, there is no suggestion or motivation for one of ordinary skill in the art to combine the reference teachings to lead to the claimed invention and, even if the cited prior art could be combined, the resulting combination fails to teach or suggest the present claims.

In view of the foregoing, withdrawal of the rejection of claims 1-19 under 35 U.S.C. §103(a) is respectfully requested.

**D. The Rejection Under the Judicially Created Doctrine of Obviousness-Type Double Patenting Is Overcome**

Claims 1-9 and 13-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable for being obvious over claims 1-10 and 13 of U.S. Patent 6,384,301.

Applicants respectfully traverse as the current claims are not obvious in view of the '301 patent claims. In particular and as described above, the '301 patent does not expressly or inherently describe each limitation of the claimed invention. Independent claims 1 and 16 (and dependent claims 2-11, 13-14, and 17-19) include the element of "obtaining an extract of root tissue from the transformed plant tissue." The '301 patent has not been shown to expressly or inherently disclose such "obtaining an extract of root tissue." The Action cited col. 9, lines 32-43 of '301 as disclosing obtaining a piece of root tissue which tested positive for GUS. However, obtaining an extract of root tissue is not disclosed in this section of the '301 patent, nor is it necessarily required. An analysis for GUS expression does not necessarily require the preparation of an extract of root tissue. Nor has any other disclosure in the '301 patent been

shown pertaining to obtaining an extract of root tissue. The claims of the current case are therefore distinct from those of the '301 patent.

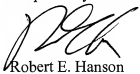
In view of the foregoing, withdrawal of the rejection is respectfully requested.

**E. Conclusion**

In view of the foregoing, it is respectfully submitted that each of the pending claims is in condition for allowance, and a Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned attorney at (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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